

REMARKS

Entry of the foregoing, re-examination and reconsideration of the subject matter identified in caption, pursuant to and consistent with 37 C.F.R. §1.116, and in light of the remarks which follow, are respectfully requested. Entry of the amendments will place this application in condition for allowance or in better condition for appeal.

Claims 1, 7 and 9 have been currently amended in response to issues raised in the final rejection. Claims 1-20 remain pending in this application.

According to paragraph (1) bridging pages 2-3 of the Office Action, claims 1, 4 and 12-15 are withdrawn from consideration as directed to a non-elected invention. However, these claims have been rejected under 35 U.S.C. §112 in paragraphs (3) and (4) on page 3 of the Office Action. Since the non-elected claims have been given an action on their merits, it appears that the restriction requirement has been withdrawn. Further, claim 1 is now dependent on product-by-process claim 16. The last sentence in paragraph (4) of the Office Action suggests that claims 1, 4 and 12-15 will be considered if they depend upon a product-by-process claim. In view of the above, it is requested that the restriction requirement be withdrawn.

Claims 1, 4, 7, 9 and 12-15 were rejected under 35 U.S.C. §112, second paragraph, for reasons set forth in paragraphs (4) and (5) of the Office Action. In response, claims 1, 7 and 9 have been amended and are now free of the terminology considered indefinite by the Examiner. Accordingly, the §112 rejection should be withdrawn and such action is earnestly requested.

Claims 3, 5-7, 16, 17 and 20 have been finally rejected under 35 U.S.C. §102(e) as anticipated by U.S. Patent No. 6,200,404 to Andersen et al for reasons given in paragraph (7) of the Office Action. Reconsideration and withdrawal of this rejection are requested for at least the following reasons.

The present invention, as defined by the claims, is directed to a strippable wall covering which is fire and abrasion-resistant and can be easily removed from walls and other substrates without requiring expensive and time-consuming techniques such as the removal of adhesives or the use of special tools. The claimed wall covering comprises a glass fiber fabric coated on both sides with a layer composed of a starch and a polymeric binder and having a layer on one side composed of paraffin wax and a rheology modifier. The second layer functions to facilitate removal of the wall covering from the surface to which it is adhered. The cited reference does not disclose a wall covering as described above.

The disclosure of Andersen et al '404 relates to environmentally friendly sheets and films for manufacturing containers. All the compositions disclosed in the working examples of this reference are used to manufacture cups. The Office Action refers to a broad statement that the sheets may be used "in any application where conventional paper or paperboard have been used" (column 47, lines 13-14). However, strippable wall coverings are not mentioned anywhere in this patent.

The wall covering of the present claims includes a glass fiber fabric. The fibers referred to in columns 23 and 24 of Andersen et al '404 are discontinuous and are added to the compositions as reinforcement; note for example, column 11, lines 6-9. Andersen et al '404 does not disclose or contemplate fabrics.

"To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently." In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429,1431 (Fed. Cir. 1997); accord Glaxo Inc. v. Novopharm Ltd., 52 F.3d 1043, 1047, 34 USPQ2d 1565, 1567 (Fed. Cir. 1995). In addition, the prior art reference must disclose the limitations of the claimed invention "without any need for picking, choosing, and

combining various disclosures not directly related to each other by the teachings of the cited reference." In re Arkley, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972).

Aside from the fact that the reference is not anticipatory because it does not disclose glass fiber fabrics, it is clear that the §102 rejection relies heavily on "picking, choosing and combining various disclosures not directly related to each other by the teachings of the cited reference."

For at least the above reasons, it is respectfully submitted that the §102(e) rejection is unsound and should be withdrawn. Such action is earnestly solicited.

Claims 2, 5, 7, 8 and 17-19 were rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 6,291,011 to Edlund in view of U.S. Patent No. 4,783,354 to Fagan for the reasons set forth in paragraph (9) of the Office Action. Also, claims 9 and 10 were rejected under 35 U.S.C. §103(a) as unpatentable over Edlund '011 in view of Fagan '354 and U.S. Patent No. 5,639,539 to De Prospero et al for the reasons provided in paragraph (10) of the Office Action. Reconsideration and withdrawal of these rejections are requested for at least the reasons which follow.

The Edlund '011 patent is assigned to and owned by Johns Manville International, Inc. The present application is assigned to or subject to an obligation of assignment to Johns Manville Europe GmbH. Johns Manville Europe GmbH is a wholly owned subsidiary of Johns Manville International, Inc. This application and the Edlund '011 patent, at the time the present invention was made, were owned by or subject to an obligation of assignment to the same person, namely, Johns Manville International, Inc.

Based on the above and pursuant to 35 U.S.C. §103(c), the Edlund '011 patent is disqualified as prior art when used as a reference under 35 U.S.C. §103(a) via §102(e). Note Section 706.02(l)(1) and (2), M.P.E.P., 8th Ed., Rev. 1. Accordingly, the §103(a) rejections based on Edlund '011 should be withdrawn.

• From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned.

Respectfully submitted,


Applicants Attorney

Robert D. Touslee
Registration No. 34,032
(303) 978-3927